UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD ALLEN COLVIN
and SUN LIN CHEN

Appeal 2006-2432
Application 10/021,200
Technology Center 1700

Decided: September 28, 2006

Before GARRIS, WARREN, and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

Appellants contend that Appellant Chen filed a affidavit under 37 C.F.R. § 1.131 (2003) on October 13, 2003, which removed

US 6,417,246 B1, published July 9, 2002, to Jia as a reference (Substitute Br. 6-7). As Appellants point out (*id.*), the Examiner held that the "[i]nstant invention, as per affidavit, was reduced to practice prior to September 21, 2000 but not prior to September 21, 1999" in the Office action mailed January 16, 2004, at page 3. The former date is the filing date of published application 09/660,111, and the latter date is the filing date of provisional application 60/155,292.

In order to apply on a document as prior art with respect to the claims under 35 U.S.C. §§ 102(e) (2002) and 103(a), the Examiner must establish that the document is in fact applicable as prior art to the claims. Here, Appellants contend that in order to rely on the filing date of the Provisional Application under 35 U.S.C. § 102(e) (2002), the Examiner must establish that the provisional application in fact supports the invention in the published application (Substitute Br. 7). The Examiner does not address the issue in the Answer.

We agree with Appellants. We find that Jia claims benefit of the provisional application under 35 U.S.C. § 119(e) (1999) and accordingly, the Examiner must establish on the record that the subject matter disclosed by Jia is properly supported in the provisional application as provided in this statutory provision in order to rely on that date under 35 U.S.C. § 102(e) (2002). *See* MPEP § 706.02, subsection V. (D), and § 706.02(f)(1), subsection II., Example 2 (8th ed., Rev. 3, August 2005).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to address the

matter discussed above, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This Remand is made for the purpose of directing the Examiner to further consider the ground of rejection advanced on appeal. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 C.F.R. § 41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

clj

The Goodyear Tire & Rubber Company
Patent & Trademark Department – D/823
1144 East Market Street
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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

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